

### **REMARKS**

The foregoing amendment places the application in condition for allowance and in better form for appeal if necessary. Entry of this amendment and reconsideration of this application are respectfully requested in view of the foregoing amendment and the following remarks.

Applicant appreciates the Examiner's willingness to discuss the matters detailed below in a telephone conference on July 3, 2002.

By the foregoing amendment, applicant has amended Claim 38 to address the Examiner's formal objections and to clarify that the redemption rate determines a value of the point total that the participants have earned pursuant to the first reward program.

Claims 24-46 remain pending.

### **ELECTION BY ORIGINAL PRESENTATION**

In the Final Rejection mailed April 10, 2002, the Examiner required restriction between two allegedly distinct inventions. The Examiner then, without attempting to contact applicant, selected one of the two groups for immediate prosecution. Applicant respectfully traverses request for withdrawal of the Examiner's election as follows.

To begin with, in the first Office Action mailed September 25, 2001, the Examiner acted on claims to both of the groups that the Examiner now contends are distinct. In particular, original Claims 1-14 related to the invention of Group I and Claims 15-23 related to the invention of Group II. As noted, the Examiner examined both sets of claims and thus should be in a position to examine both groups of claims as amendment. More significantly, however, applicant objects to and requests withdrawal of the Examiner's presumptive "election by original presentation." In fact, as clearly demonstrated above, both groups of claims were originally

presented. Thus, there is no proper basis for an election by original presentation as set forth in the Office Action. Instead, the Examiner having decided to require a restriction should have contacted the applicant or issued a restriction requirement. Election by original presentation is not proper under the present circumstances and cannot be maintained. In fact, should the Examiner maintain the restriction requirement, applicant specifically requests that, contrary to the Examiners presumptive election, applicant elect Claims 24-37 for immediate prosecution on the merits without prejudice to his right to file a subsequent divisional application direct to Claims 38-46.

In this regard, applicant notes that the subject matter of Claims 24-36 was indeed originally presented in the very first claims as originally filed. Thus, applicant requests that the restriction requirement be withdrawn and an Office Action issued on all the claims. However, should the Office Action be maintained, applicant respectfully requests that examination on the invention of Group 1, Claims 24-36 which were indeed the truly originally presented claims in this application.

Should the Examiner decide not to grant applicant request for an opportunity to elect a Group for examination, then applicant respectfully requests that the Examiner provide the detailed basis for election by original presentation so that applicant may request appropriate supervisory review of the Examiner's determination.

#### **RESPONSE TO CLAIMS 37-46**

For completeness and to frame the issue for Appeal, if necessary, applicant is responding hereto to the substantive action on the merits of Claims 37-46 although, as detailed above, these

are not the claims that applicant would have, given the opportunity, elected for examination on the merits.

In the Office Action mailed April 10, 2002, the Examiner rejected Claim 38 under Section 112 as containing certain informalities. Specifically, the Examiner indicated that there was no antecedent support for the terms "the value" and "the points". In fact, the Examiner will note that, on line 6 of Claim 30, there is indeed an indication that participants may earn "points" for certain actions. Nonetheless, for purposes of clarity, Claim 38 has been amended to provide explicit antecedent support. The applicant has further amended the claims to clarify the significant "redemption rates" features. These changes are not believed to affect the scope of the claim and entry is therefore requested.

Examiner further rejected Claims 38-42 as unpatentable over Deluca, et al. Moreover, Claims 38-46 were rejected over the combination of Deluca and Cook. These rejections are traversed.

Judging from the detailed explanation of the Examiner's rejection, it appears that the Examiner is taking the position that the term "redemption rate" as used in the present specification can be considered equivalent to a point total associated with each participant. Applicant respectfully submits that such an interpretation of the term "redemption rate" is entirely inconsistent with the specification. See for example, page 31, line 24 thru page 34, line 23, which makes it clear that the redemption rate is not a point total, but rather a coefficient used to calculate the value of program points value based on multiplication of the redemption rate times the base points total. To provide further clarity, applicant has amended Claim 38 to require that a point total is associated with each participant and that the redemption rate associated with

each participant ID determines the value of the points point total associated with that participant pursuant to the first reward program.

Deluca does not even remotely suggest a system in which a redemption rate that is associated with each participant ID determines the value of the point total associated with that participant in a first reward program. For at least this reason, reconsideration and withdrawal of the final rejection is respectfully requested.

Moreover, with regard to Claims 43-46, applicant respectfully submits that the Examiner has failed to establish an appropriate grounds for rejection under Section 103.

35 U.S.C. § 103 authorizes a patent examiner's rejection of a claim where, to meet a claim, it is necessary to modify a single prior art reference or to combine it with one or more other teaching references. The Manual of Patent Examining Procedure ("MPEP") states that the examiner, after indicating that the rejection is under 35 U.S.C. § 103, should set forth "(1) the difference(s) in the claim over the applied reference(s), (2) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (3) an explanation why such a proposed modification would be obvious." MPEP § 706.02. This is in accordance with the three-part inquiry for § 103 obviousness set forth by the Supreme Court in Graham v. John Deere, 148 USPQ 459 (1966). Thus, to find the subject matter of claim 18 obvious, the examiner must provide an explanation why the proposed modification would have been obvious.

To establish obviousness, there must be a suggestion or motivation in the references to do so. Id. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could both be turned upside down without motivation to do so). It is evident from Federal Circuit case law that the preferred method of establishing motivation or suggestion for modification is to rely on a

suggestion within the primary reference or to find such a suggestion in a teaching reference. As stated in Fine, "'To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall notion to the invidious effect of a hindsight syndrome.'" 5 USPQ2nd at 1600 (quoting W.L. Gore & Assoc. v. Garlock, Inc., 220 USPQ 303, 312-13). Accord Mills, 16 USPQ2nd at 1432: In re Demenski; 230 USPQ 313, 315 (Fed. Cir. 1986) (reversing rejection of claims where no suggestion existed in the prior art references to make proposed design modification and rejecting Board's argument as hindsight that the proposed modification was "common practice"). See also Northern Telecom, Inc. v. Data Point Corp., 15 USPQ2nd 1321, 1323 (Fed. Cir. 1990), (rejecting "routine design choice" absent any suggestion in the prior art to make proposed modification).

As applied to the determination of patentability vel non when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section." In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

"The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'" (quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998))); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed

combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

In this instance, the examiner has not adequately supported the selection and combination of the Deluca and Cook references to render obvious the claimed invention. Moreover, the combination would not yield two reward programs as claimed. The examiner relies on the advantages taught by the present inventor to provide the requisite motivation. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the conclusion.

For these reasons, applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and prompt issuance of a Notice of Allowance.

Serial No.: 09/365,748  
Art Unit: 2162

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Should the Examiner determine that any action is necessary to place this application into even better form, he is encouraged to contact applicant at the number listed below.


SHAW PITTMAN LLP  
1650 Tysons Boulevard  
McLean, VA 22102  
Tel: 703/770-7900

Date: July 5, 2002

Respectfully submitted,

MICHAEL D. BEDNAREK

By:

  
Michael D. Bednarek  
Registration No. 32,329

Attachments: Amended Claims w/ Markings

MDB/lrhj



**VERSION WITH MARKINGS TO SHOW CHANGES MADE TO CLAIMS**

38. (Amended) A computer implemented incentive program for encouraging certain participant actions, the program comprising:

a plurality of participants;

a participant ID associated with each participant;

a redemption rate associated with each participant ID;

a first reward program under which participants may earn points for certain actions

wherein a point total is associated with each participant;

a second reward program through which the redemption rate associated with a particular participant is adjusted in response to certain [participant] action by that participant; and

wherein the redemption rate associated with each participant ID determines [the] a value of the [points earned by] point total associated with that participant pursuant to the first reward program.